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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 10

Application Number: 08/886,516
Filing Date: July 1, 1997
Appellant(s): Berson et al.

Alberta A. Vitale
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed October 29, 1999.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-3 and 5-11 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,949,381	Pastor	08-14-90
5,607,187	Salive et al.	03-04-97
5,592,561	Moore	)1-07-97
3,701,165	Huddleston	10-31-72

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. Claim 1-2 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Salive.

Moore (5,592,561) teaches verifying an article of manufacture comprising the following steps: preparing information related to said article (column 12 lines 29-45), encrypting a portion of said information (column 4 lines 3-6) and securely associating said article with said encrypted information(column 1 lines 28-32). Moore fails to teach labeling and securely associating said label with said article. Salive et al. (5,607,187) teaches in column 1 lines 5-10, placing information related to said article on a label and securely associating said label with said article in an inventory control system similar to Moore's. It would have been obvious to modify Moore's inventory control system to include Salive's placing information related to said article on a label and securely associating said label with said article rather than printing the information on the

article itself as this would enable more items to be controlled as some items would not easily be printed on.

The verifying information of claim 2 is taught by the distribution information (column 12 lines 29-46) of Moore as if the information was copied it would not be delivered to the proper distributor.

The unreproducible information of claim 4 is taught by the column 12 teaching of Moore's encrypted information.

The scanning said label and comparing features of claims 10-11 are taught by Moore's scanning and comparison circuits (see column 4 first paragraph of Moore).

The applicant states that his invention includes an unreproducible pattern associated with the label and an encrypted portion which includes information from the unreproducible pattern. Moore teaches a mark, symbol, or pattern which is not visible until exposed to certain frequencies or wavelengths of visible or nonvisible light which renders them readable (col. 12, line 47-65). The mark, symbol, or pattern consists of information which may be encoded entries (col. 12, line 29-46). Thus, Moore's printed object is unreproducible without the proper key and/or frequency of light.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Salive as applied to claim 1 above, further in view of that which is well known in the art.

Moore-Salive teaches unique identifications of articles, identification of the provider of said article and a description of said articles (for all see column 12 of Moore) but fails to disclose expiration dates of items. Official notices is taken that expiration dates of items is well known in the art of labeling articles. For example milk, bread, soda, etc. It would have been obvious to modify Moore in view of Salive inventory control system to include expiration dates than not include it as this would reduce the chance of soiled items being sold.

Those arguments stated in "1." above, hold here.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Salive et al. as applied to claim 4 above, and further in view of Huddleston.

Moore-Salive teaches an unreproducible pattern (column 12 of Moore) but fails to disclose that said pattern is formed of magnetic fibers embedded in said label. Huddleston it is well known to use magnetic fibers embedded in a label to mark an item in an inventory control system similar to Moore's. See Abstract. It would have been obvious to modify Moore-Salive inventory control system to include magnetic fiber marking rather other types of marking as suggested by column 2 reference to Huddleston in Moore.

Those arguments stated in "1." above, hold here.

First, the examiner holds that Huddleston's application of magnetic particles to fabric in a manner as to allow detection when a magnetic detector or head is passed over them is within the applicant's field of endeavor. Both inventions may include magnetic fibers applied in a manner as to create a mark which communicates a fact to the reader of that mark. Both inventions require special devices to read the mark. Under normal operating conditions, both inventions possess secure labels-only being removed with the application of a solvent or non-ordinary action.

Second, as stated in the above paragraph, the examiner does believe that the invention of Huddleston is prudent to the inventor's particular problem. Thus, Huddleston is held as analogous art.

4. Claim 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Salive, further in view of Pastor.

Moore-Salive teaches a generic encryption algorithm to encrypt information but fails to recite public key encryption. Pastor teaches it is well known to use public key encryption in an inventory control system similar to Moore's. See Abstract. It would have been obvious to modify Moore-Salive inventory control system to include public key encryption rather than generic encryption as public key encryption works well for authentification.

Those arguments stated in "1." above, hold here.

(11) Response to Argument

A. Rejcctions of Claims 1, 2, 10, and 11.

Claim 1: Moore's "printed object is unreproducible without the proper key and/or fequency of light". Logically, the converse is true that the printed object is reproducible with the proper key and/or frequency of light.

The printed identifier is only reproducible if one can first detect & locate the identifier, second to produce chemical agents that are visible under the same frequency of radiation, and third to duplicate the mark. Once read, the data embedded in the symbols must still be decoded. (See Moore col. 12, line 31-33).

Salive is not directed to counterfeiting.

In response to applicant's argument that Salive is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*,

977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the process of labeling to track items is pertinent to the applicant's invention.

Claim 2: Moore in view of Salive do not teach use of verifying information for the protection against unauthorized use of duplicate labels.

(See claim 1) Moore teaches goods verification using the applied mark, pattern, or symbol containing encoded data (col. 12, line 43-46).

Claim 10: Moore in view of Salive does not teach providing a label for the article with an unreproducible pattern; encrypting at least a portion of the signal; securely associating a tangible representation of the encrypted portion of the signal, the article and the label.

(See claim 1) Moore teaches a computer system controlling the marking with manufacture data in the I.D. Matrix format (col. 11, line 56-67) and the host computer allots a number of prints to the printer & enables the printing of marks on the goods or material (col. 9, line 4-10).

Claim 11: Moore in view of Salive do not teach scanning, decrypting, and comparing to verify a label.

(See claim 10) Moore teaches an optical reader scans the marked products and cross references the scanned information with the encoded data to confirm that the appropriate marks or symbols were placed on the appropriate goods or materials (col. 18, line 15-22).

C. Moore in view of Salive claim 3 rejection.

No encryption information is taught by the above references.

(See claim 2, sec B) Moore teaches the use of encoded data (col. 12, line 43-46)- encoding is equivalent to encrypting.

No expiration date, unique identification, identification of a provider or information describing an article in the context of encryption as in the claimed invention is well known in the art.

Moore teaches the time, the date, type of product, the count, the location of manufacturing, the ordering customers, the user ID and password of the supervisor or printer operator, the individual user ID and password of the authorized person or persons, and any routing customer information typically is represented by symbology in code form (col. 18, line 6-14).

D. Moore in view of Salive, et al., further in view of Huddleston claim 5 rejection.

1) Huddleston is non-analogous art.

In response to applicant's argument that Moore in view of Salive, further in view of Huddleston is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Huddleston teaches the marking of garments which will be detected for cutting, stitching, folding, and placement steps can be carried out on different textile goods..

2) Does not teach an unreproducible pattern and encrypted portion.

(See claim 1, section B)

E. Moore in view of Salive, further in view of Pastor claim 6-9 rejection.

1) Pastor does not teach the use of public/private keys for verifying the source of an article of manufacture.

Pastor teaches the subject invention security against production of counterfeit indicia not found in making the printer physically secure but in the form of indicia (col. 3, line 50-53). Pastor teaches of the subject invention, the message is encrypted using a public key encryption system such as RSA. The RSA algorithm uses public and private keys for encryption and decryption.

Pastor is directed to a different field and a different problem, thus it is nonanalagous art.

In response to applicant's argument that Pastor is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Pastor teaches an item bearing bit-mapped indicia with information encrypted by a public key which verifies a status of the item and method & apparatus for applying such indicia.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Todd Jack

November 9, 1999

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